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OFFICE OF PETITIONS

In re Patent No. 6,838,042 :
Wieners et al. :
Issue Date: January 4, 2005 : DECISION ON
Application No. 10/089,261 : REQUEST FOR RECONSIDERATION
Filed: March 26, 2002 : OF
Atty Docket No. 99/N007 TPA : PATENT TERM ADJUSTMENT

This is a decision on the "REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT INDICATED IN THE ISSUE NOTIFICATION (37 C.F.R. § 1.705," filed January 7, 2005. Patentees request that the patent term adjustment shown on the Issue Notification (and indicated in the patent) be corrected from one hundred seventy-six (176) days to two hundred ninety-six (296) or in the alternative, two hundred seventy-three (273) days.

The request for reconsideration of the patent term adjustment under § 1.705(d) is **DISMISSED**.

Patentees are given TWO (2) MONTHS from the mail date of this decision to respond. No extensions of time will be granted under § 1.136.

On January 4, 2005, application No. 10/089,261 matured into U.S. Patent No. 6,838,042. The instant request for reconsideration filed January 7, 2005, was timely filed within 2 months of the date the patent issued. See § 1.705(d). The Patent issued with a revised Patent Term Adjustment of 176 days. The PTA of 296 days was reduced by 120 days pursuant to 37 CFR § 1.704(c)(10) for the submission of a paper after the mailing of the notice of allowance.

Patentees acknowledge submitting an English translation of a German parent application on July 8, 2004, after the mailing of the notice of allowance on July 8, 2004. Yet, patentees argue that the reduction under § 1.704(c)(10) should not be applicable in this case. Patentees contend, in the alternative, that the paper filed July 8, 2004 should be

- i) considered under 37 CFR 1.704(c)(8) as a supplemental reply requested by the Office, due to the requirements of 37 CFR 1.55(4) and thus, no period of reduction should be entered;
- ii) considered under 37 CFR 1.704(c)(8) as a supplemental reply causing a reduction of 23 days, as the Examiner did not make an express request for the English translation; or
- iii) considered under 37 CFR 1.704(c)(10), but be categorized as a response to the Examiner's reasons for allowance, i.e. the Examiner allowed the case based on the removal of the cited references and thus, no period of reduction should be entered.

Patentees' arguments have been considered, but not found persuasive. The paper filed July 8, 2004, is not considered a supplemental response.

The filing of the paper filed July 8, 2004 after the mailing of a Notice of Allowance is properly a basis for reduction of patent term adjustment pursuant to § 1.704(c)(10).

37 CFR § 1.704(c)(10) provides that:

Submission of an amendment under § 1.312 or other paper after a notice of allowance has been given or mailed, in which case the period of adjustment set forth in § 1.703 shall be reduced by the lesser of:

(i) The number of days, if any, beginning on the date the amendment under § 1.312 or other paper was filed and ending on the mailing date of the Office action or notice in response to the amendment under § 1.312 or such other paper;

or

(ii) Four months;

In this instance, it is undisputed that the paper was filed after the mailing of the Notice of Allowance. Accordingly, pursuant to § 1.704(c)(10), the patent term adjustment was properly reduced by the lesser period of four months.

By Notice entitled *Clarification of 37 CFR 1.704(c)(10) - Reduction of Patent Term Adjustment for Certain Types of Papers Filed After a Notice of Allowance*, 1247 OG 111 (June 26, 2001), the Director set forth examples of papers deemed not to cause substantial interference and delay in the patent issue process. The paper filed July 8, 2004, is not a Comments on Statements of Reasons for Allowance or merely a request to correct an error or omission in the Notice of Allowance or Notice of Allowability. Submission of a paper of the type submitted on July 8, 2004 was not identified in the Notice. Other than those papers identified in this Notice, all papers filed after allowance of an application substantially delay the Office's ability to process an application for a patent because the Office does not wait until payment of the Issue Fee to begin the patent issue process. As a result, 37 CFR 1.704(c)(10) does not distinguish between papers that are and are not required by the Office. Thus, filing of the paper after allowance will be treated as a failure to engage in reasonable efforts to conclude prosecution.

In view thereof, it is concluded that the patent properly issued with a revised Patent Term Adjustment of one hundred seventy-six (176) days.

Receipt is acknowledged of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

Telephone inquiries specific to this matter should be directed to Nancy Johnson, Senior Petitions Attorney, at (571) 272-3219.

Handwritten signature of Karin Ferriter in cursive script, with the word "for" written below it.

Karin Ferriter
Senior Legal Advisor
Office of Patent Legal Administration
Office of Deputy Commissioner
for Patent Examination Policy